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10/733,102	12/10/2003	Osama Elkady	50277-2319	9183
43425 7590 06/18/2008 HICKMAN PALERMO TRUONG & BECKER/ORACLE 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110-1083				
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MCLEAN, NEIL R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,102

Applicant(s)

ELKADY ET AL.

Examiner

Neil R. McLean

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S509)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/13/2008 has been entered.

Status of Claims

2. Claims 1-28 are now pending in this application.
Independent Claim 1 has been amended.
Claim 13 which depends on Claim 1 also has been amended.

Response to Arguments

3. Applicant's arguments filed 3/13/2008, with respect to the rejection(s) of claim(s) 1-28 under *Schwieb et al.* (US 7,202,972) have been fully considered and are persuasive. However, upon further consideration, a new ground(s) of rejection is made in view of *Palmer* (US 6,078,403).

4. Regarding Applicant's Argument:

"Schwier does not disclose "on the computer system, merging a first merge document and a second merge document" that are in a "merge format".

Examiner's Response:

Schwieer does not disclose expressly "on the computer system, merging a first merge document and a second merge document" that are in a "merge format".

Palmer discloses "on the computer system, merging a first merge document and a second merge document" that are in a "merge format".

(Base document 44 and document definition file 46 are received as inputs by post processor 50, which preferably comprises a custom application (such as the IBM product MERGEDOC) running on computer system 14 or another computer system within network 28. However, in an alternative embodiment of the present invention, post processor 50 comprises an additional extension to user application 40. In response to receipt of base document 44 and document definition file 46, post processor 50 produces a merged document 52, which comprises one or more files that incorporate base document 44 and selected variable data 48 as described in Column 4, lines 1-24).

Palmer & Schwier are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of merging documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to "on the computer system, merging a first merge document and a second merge document" that are in a "merge format".

The suggestion/motivation for doing so would be to: e.g., If multiple substantially similar copies of a document are desired, ripping the document can be expedited by identifying fixed and variable portions of the document, ripping the fixed portion (the base document) only once, and using the resulting dot pattern for each copy of the document as disclosed by Palmer in Column1 lines 55-60.

Therefore, it would have been obvious to combine Palmer's method for processing a base document within a user application, wherein the base document includes at least one variable data area with Schwier's system for transmitting computer data to an output device to obtain the invention as specified.

5. Regarding Applicant's Argument:

"Schwier does not teach "after generating the composite merge document, delivering said composite merge document to an output device."

Examiner's Response:

Schwier does not disclose expressly "after generating the composite merge document, delivering said composite merge document to an output device."

Palmer discloses "after generating the composite merge document, delivering said composite merge document to an output device." (Merged document 52 is then transmitted to printer 12 as shown in Figure 2 and disclosed in Column 4, line 25).

Palmer & Schwier are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of merging documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to merge variable and static data prior to sending to a printer.

The suggestion/motivation for doing so would be to take of advantage of the high speed print on demand print environments that are capable of producing 400 pages per minute (100 pages per minute in full color) at resolutions of 600 pels per inch or greater. The high performance requirements of a POD environment necessitate the transfer of massive amounts of data to the printhead--on the order of 30 MB per second.

Therefore, it would have been obvious to combine Palmer's method for processing a base document within a user application, wherein the variable and static data are merged prior to being sent to a printer with Schwier's system for transmitting computer data to an output device to obtain the invention as specified.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwier et al. (US 7,202,972) in view of Palmer (US 6,078,403).

Regarding Claim 1: (currently amended)

Schwier et al. discloses a method comprising:

receiving (In order to merge the system must receive a merge command from the browser or program code), at a merge utility (e.g., Winword Application 10 in Figure 2) executing on a computer system (e.g., Personal Computer 1 in Figure 1), a first merge document (e.g., Static Data 12 created by WinWord Application 10 in Figure 2) that is in a merge format;

converting a second document (e.g., Excel document) from an original format to the merge format to create a second merge document (e.g., Master Document described in Column 9, lines 32-35);

wherein the second document was created by a first document authoring application (e.g., WinWord Program 10 in Figure 2);

wherein the second merge document is in the merge format;

wherein the step of converting is performed by either the merge utility or the first document authoring application (e.g., Column 5, lines 23-43);

using the merge utility executing on the computer system, merging the first merge document (e.g., Variable Data V) and the second merge document (e.g., Static Data S) to generate a composite merge document (e.g., V+S (EMF) 13 in Figure 2;);
and

after generating the composite merge document delivering said composite merge document to an output device (e.g., Figure 8 is a functional block diagram of a print operation; Column 9, lines 1-3);

wherein the output device is a device that is different from the computer system;

wherein the original format is a format that is not supported by the output device (e.g., Step 47 "Is Output Format EMF?" in Figure 8; described in Column 9, lines 25-34);
and

therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (Referring to Figure 8; When the query to "Is Output Format EMF?" yields "NO"; Kernel Mode 53 is activated; Described in Column 9, lines 25-34); and

wherein the merge format is a format that is supported by the output device (Referring to Figure 8; When the query to "Is Output Format EMF?" yields "YES"); and

therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (Described in Column 9, lines 11-24).

Schwier does not disclose expressly "on the computer system, merging a first merge document and a second merge document" that are in a "merge format".

Palmer discloses "on the computer system, merging a first merge document and a second merge document" that are in a "merge format".

(Base document 44 and document definition file 46 are received as inputs by post processor 50, which preferably comprises a custom application (such as the IBM product MERGEDOC) running on computer system 14 or another computer system within network 28. However, in an alternative embodiment of the present invention, post processor 50 comprises an additional extension to user application 40. In response to receipt of base document 44 and document definition file 46, post processor 50 produces a merged document 52, which comprises one or more files that incorporate base document 44 and selected variable data 48 as described in Column 4, lines 1-24).

Palmer & Schwier are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of merging documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to "on the computer system, merging a first merge document and a second merge document" that are in a "merge format".

The suggestion/motivation for doing so would be to: e.g., If multiple substantially similar copies of a document are desired, ripping the document can be expedited by identifying fixed and variable portions of the document, ripping the fixed portion (the

base document) only once, and using the resulting dot pattern for each copy of the document as disclosed by Palmer in Column 1 lines 55-60.

Therefore, it would have been obvious to combine Palmer's method for processing a base document within a user application, wherein the base document includes at least one variable data area with Schwier's system for transmitting computer data to an output device to obtain the invention as specified in Claim 1.

Schwier does not disclose expressly "after generating the composite merge document, delivering said composite merge document to an output device."

Palmer discloses "after generating the composite merge document, delivering said composite merge document to an output device." (Merged document 52 is then transmitted to printer 12 as shown in Figure 2 and disclosed in Column 4, line 25).

Palmer & Schwier are combinable because they are from the same field of endeavor of image processing; e.g., both references disclose methods of merging documents.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to merge variable and static data prior to sending to a printer.

The suggestion/motivation for doing so would be to take of advantage of the high speed print on demand print environments that are capable of producing 400 pages per minute (100 pages per minute in full color) at resolutions of 600 pels per inch or greater. The high performance requirements of a POD environment necessitate the transfer of massive amounts of data to the printhead--on the order of 30 MB per second.

Therefore, it would have been obvious to combine Palmer's method for processing a base document within a user application, wherein the variable and static data are merged prior to being sent to a printer with Schwier's system for transmitting computer data to an output device to obtain the invention as specified in Claim 1.

Regarding Claim 2: (original)

Schwier et al. further discloses the method of claim 1 further comprising: generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2).

Regarding Claim 3: (original)

Schwier et al. further discloses the method of claim 1, wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 4: (original)

Schwier et al. further discloses the method of claim 3, wherein the merge format is PDL Postscript (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or **postscript**').

Regarding Claim 5: (original)

Schwier et al. further discloses the method of claim 1, wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 6: (previously presented)

Schwier et al. further discloses the method of claim 5, wherein the background template document is originally created by a second document authoring **application** (Column 5, lines 23-30; 'Various application programs in turn run under this operating system, for example the **application** 10 Winword 97.RTM. from the Microsoft Office 97.RTM. package'); and

wherein the second document authoring application is different (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) from said first document authoring application.

Regarding Claim 7: (original)

The method of claim 5, wherein the background template document is created in a second original format (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) and converted from the second original format to the merge format (See PCL converter 18 in Figure 2).

Regarding Claim 8: (previously presented)

Schwier et al. further discloses the method of claim 7, wherein the conversion of the second original document to the merge format occurs at the merge utility (Column 7, lines 4-6; 'these **variable data 15** are then merged by an OR-operation with the static data stored in the memory 8 to form merged variable and static data 19').

Regarding Claim 9: (previously presented)

Schwier et al. further discloses the method of claim 1, wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the original format, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to a document authoring application (Column 4, lines 15-20); and

the first document authoring application generating the second merge document based on said set of conversion instructions (Column 4, lines 15-20).

Regarding Claim 10: (previously presented)

Schwier et al. further discloses the method of claim 1, wherein the method further comprises receiving a request to merge documents containing information about

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a document authoring application (Column 4, lines 25-26; 'the referencing is thereby particularly controlled via data that are input via a user interface') that created the second document; and

wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the information about the document authoring application, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to the document authoring application (Column 9, lines 59-62; "Enhanced Print Environment (EPE) Print Processor" 49a does not forward the EMF data directly to the port monitor 51 but calls the converter unit 58, wherein the EMF data stream is converted into a PCL print data stream 60'); and

the document authoring application generating the second merge document based on said set of conversion instructions (Column 9, lines 65-67, 'The conversion is thereby controlled by the parameters that were previously input via the input module 59').

Regarding Claim 11: (original)

Schwier et al. further discloses the method of claim 1, wherein the composite merge document is in the merge format (Column 3, lines 56-67).

Regarding Claim 12: (original)

Schwier et al. further discloses the method of claim 1, wherein the composite merge document is a **template** for creating other documents (FIG. 5 shows a **master** document 25).

Regarding Claim 13: (currently amended)

Schwier et al. further discloses the method of claim 1, further comprising;

Receiving at the merge utility, a request to merge wherein the steps of converting the second document and merging the first merge document and the second merge document are both performed in response to the merge utility receiving the request to merge documents. documents (The program code which is embodied on a computer readable media and operable to requests the merge utility described in Column 6, lines 8-18 to merge documents and in Claim 20.)

Regarding Claim 14: (previously presented)

Schwier et al. further discloses the method of claim 1 further comprising:

receiving at the merge utility, a request to merge documents (Column 7, lines 20-25; in order to merge the system must receive a merge command);

generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2);

wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript');

wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

wherein the background template document is originally created by a first document authoring application; and

wherein the second document authoring application that is different from said first document authoring application;

wherein the background template document is created in a second original format and converted from the second original format to the merge format.

Regarding Claim 15: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 1 (The program code or device which performs the functions described in Claim 1).

Regarding Claim 16: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 2 (The program code or device which enables the PCL converter 18 in Figure 2 to initiate the method described in Claim 2).

Regarding Claim 17: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 3 (The program code or device which performs the function described in (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 18: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 4 (The program code or device which performs the function described in (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 19: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 5 (The program code or device which performs the function described in Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) or a **watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 20: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 6 (The program code or device which performs the functions described in Claim 6).

Regarding Claim 21: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 7 (The device or program code which performs the functions described in Claim 7).

Regarding Claim 22: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors,

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causes the one or more processors to perform the method recited in claim 8 (The program code or device which performs the function described in (Column 7, lines 4-6; 'these **variable data** 15 are then merged by an OR-operation with the static data stored in the memory 8 to form merged variable and static data 19').

Regarding Claim 23: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 9 (The program code or device which performs the function described in Claim 9).

Regarding Claim 24: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 10 (The program code or device which performs the function described in Claim 10).

Regarding Claim 25: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 11 (The program code or device which performs the function described in Column 3, lines 56-

67).

Regarding Claim 26: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 12 (The program code or device which performs the function as described in Claim 12).

Regarding Claim 27: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 13 (The program code or device which enables the devices shown in Figure 1 to initiate a request to merge command).

Regarding Claim 28: (previously presented)

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 14 (The program code or device which describes the process as described in Claim 14).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sciatto (US 6,330,073) discloses A system and method for generating a plurality of customized documents having at least one portion of common information and at least one portion of variable information.

Examiner Notes

7. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is (571)270-

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1679. The examiner can normally be reached on Monday through Friday 7:30AM-4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neil R. McLean/
Examiner, Art Unit 2625
6/13/2008

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625